

## **REMARKS**

In the Office Action mailed February 27, 2007, the Examiner reopened prosecution on the merits, objected to Claims 45 and 56, rejected Claims 42 and 48 under 35 U.S.C. §102(e) and 102(g). Each objection and rejection is addressed below.

### **I. Objection to Claims 45 and 56**

The Examiner stated, “Claims 45 and 56 are objected to as being dependent upon a rejected claim base, but would be allowable if rewritten in independent form including all of the base claim and any intervening claims.” Office Action, page 2. Applicants believe that claims 42 and 48, from which claims 45 and 56 depend, are patentable. As such, no amendment is made to claims 45 and 56 at this time.

### **II. Rejection of Claims 42 and 48 under 35 U.S.C. §102(e)**

Claims 42 and 48 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,172,187 (hereinafter, “the Reed patent”). In particular, the Examiner stated, “Reed et al. teach the isolated and purified CD40 bp protein comprising amino acids 297-567 of SEQ ID NO: 2 (e.g., cols. 2, 3, & 7 (line 42) – 8 (line 46)); Figure 1; as it relates to claim 42). Pharmaceutical compositions are disclosed in column 18 (lines 49-66) (i.e., as it relates to claim 48). Note that Reed’s amino acid positions #s 273-543 of SEQ ID NO: 2 of the instant application, and therefore, encompass claims 1-2, 4-6, 15, 16 & 19 of ‘187.” Office Action, page 3. The Examiner further stated, “It should be noted that the Dixit Declaration of 7/05/96 cannot overcome this rejection, even though it does overcome any potential rejection under 102(e) for allowed claims 45 & 48.” Office Action, page 3.

Respectfully, the Applicant disagrees with the Examiner’s assertion that the Dixit Declaration does not overcome the pending 35 U.S.C. §102(e) rejection. The 37 C.F.R. §1.131 Declaration provided by Inventor Dixit on July 5, 1996 (hereinafter, “the Dixit Declaration”) established that the present invention was conceived and reduced to practice prior to November 11, 1994. In support, the Dixit Declaration provided the manuscript for the Hu, et al., 1994 Journal of Biological Chemistry 269(48):30069-30072 (hereinafter, “the Hu reference”) demonstrating this point.

The Applicant disclosed the isolated and purified CD40 bp protein comprising amino acids 297-567 of SEQ ID NO: 2 (corresponding to amino acid positions #s 273-543 of SEQ ID NO: 2 of the Reed patent) in the Hu reference at pages 30071-30072. The Hu reference was received for publication on September 22, 1994 – well before the Reed patent’s earliest priority date of December 2, 1994. As such, the Applicant conceived and reduced to practice the subject matter of the claimed invention prior to the Reed patent. The Applicant requests these rejections be withdrawn.

**II. Rejection of Claims 42 and 48 under 35 U.S.C. §102(g)**

Claims 42 and 48 are rejected under 35 U.S.C. §102(g) based upon claims 1-2, 4-6, 15, 16 and 19 of the Reed patent. The Examiner stated, “Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is the first inventor in this country.” Office Action, page 4.

The Applicant is the first inventor for the claimed subject matter in this country as evidenced by the submission of the Hu reference, which predates the earliest priority date of the Reed patent. The Applicant makes no concession that the patentee of the Reed patent is the first inventor of the claimed subject matter in this country. The Applicant is not disclaiming the subject of the present application.

Accordingly, per MPEP §2304.02, the Applicant suggests an Interference between U.S. Patent Application Serial No. 08/826,577 and U.S. Patent No. 6,172,187.

Per MPEP §2304.02(1), the Applicant seeks an Interference with U.S. Patent No. 6,172,187.

Per MPEP §2304.02(2), the Applicant believes Claims 1-2, 4-6, 15, 16 and 19 of U.S. Patent No. 6,172,187 interfere with Claims 42 and 48 of U.S. Patent Application Serial No. 08/826,577. The Applicant proposes the following count:

**PROPOSED COUNT:**

A purified protein or polypeptide comprising:  
amino acids 297 to 567 as shown in SEQ. ID NO. 2 of U.S. Patent  
Application Serial No. 08/826,577; OR

amino acids 273 to 543 as shown in SEQ. ID NO. 2 of U.S. Patent No. 6,172,187.

Per MPEP §2304.02(3), a claim chart is provided demonstrating why Claim 42 of U.S. Patent Application Serial No. 08/826,577 and Claim 1 of U.S. Patent No. 6,172,187 correspond with the proposed count:

<b>PROPOSED COUNT:</b>	<b>Claim 42 of U.S. Patent Application Serial No. 08/826,577:</b>	<b>Claim 1 of the U.S. Patent No. 6,172,187:</b>
A purified protein or polypeptide comprising:  amino acids 297 to 567 as shown in SEQ. ID NO. 2 of U.S. Patent Application Serial No. 08/826,577;  OR  amino acids 273 to 543 as shown in SEQ. ID NO. 2 of U.S. Patent No. 6,172,187.	1. A purified protein or polypeptide comprising amino acids 297 to 567 as shown in SEQ. ID NO. 2.  <b>*In comparison with the proposed count, Claim 42 recites amino acid sequences encompassed within amino acids 297 to 567 of SEQ ID NO: 2 of U.S. Patent Application No. 08/826,577. As such, Claim 42 of U.S. Patent Application No. 08/826,577 is encompassed within the proposed count.</b>	1. A purified mammalian CD40-Associated Protein (CAP), wherein said protein binds to the cytoplasmic domain of CD40, and wherein said protein comprises a TRAF domain set forth as amino acids 385 to 536 of SEQ ID NO:2.  <b>*In comparison with the proposed count, Claim 1 recites amino acid sequences encompassed within amino acids 273 to 543 of SEQ ID NO: 2 of U.S. Patent No. 6,172,187. As such, Claim 1 of U.S. Patent No. 6,172,187 is encompassed within the proposed count.</b>

Per MPEP §2304.02(4), the Applicant of U.S. Patent Application Serial No. 08/826,577 will prevail on priority because the Applicant disclosed the isolated and purified CD40 bp protein comprising amino acids 297-567 of SEQ ID NO: 2 (corresponding to amino acid positions #s 273-543 of SEQ ID NO: 2 of the Reed patent) in the Hu reference at pages 30071-30072. The Hu reference was received for publication on September 22, 1994 – well before the Reed patent’s priority date of December 2, 1994. As such, the Applicant conceived and reduced to practice the subject matter of the claimed invention prior to the Reed patent.

Per MPEP §2304.02(5), no claims have been added or amended to provoke an interference.

Per MPEP §2304.02(6), for the constructive reduction to practice for which the Applicant wishes to be accorded benefit, the Applicant directs the Examiner to the Hu reference at pages 30071-30072. In addition, the Applicant directs the Examiner to SEQ ID NO: 2 and page 37, ones 10 through 33 of the present application.

### **III. Conclusion**

All grounds of rejection of the Office Action of May 26, 2006 have been addressed and reconsideration of the application is respectfully requested. Should the Examiner believe that a telephone interview would aid in the prosecution of this application Applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

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